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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,254	11/01/2000	Blaine Garst	19004-009002	3557

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EXAMINER

GREENE, DANIEL LAWSON

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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09/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/704,254

Applicant(s)

GARST ET AL.

Examiner

Daniel L. Greene Jr.

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-86, 88-92 and 94-147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-86, 88-92 and 94-147 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants amendments in response to sections 8, 9a and 9b of the previous Office action mailed 1/25/2007 are acceptable and overcome the contentions therein, accordingly said contentions are withdrawn.
2. Applicant's arguments, see pages 12-15, filed 6/20/2007, with respect to the rejection(s) of claim(s) 84-92 and 94-104 under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wyman (U.S. Patent 5,204,897) in view of Applicants Admitted Prior Art (APA) (Section 10 of the previous Office action) and under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ross (U.S. Patent 5,553,143) in view of Applicants Admitted Prior Art (APA) (Section 11 of the previous Office action) have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, new ground(s) of rejections are made in view of the same previous rejections with the addition of case law to show it would have been obvious to integrate the access authorization indicator into the software program itself.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 84-86, 87-92 and 94-104 are rejected under 35 U.S.C. 103(a) as being obvious over Wyman (U.S. Patent 5,204,897) in view of Applicants Admitted Prior Art (APA) for the reasons set forth in section 10 of the previous Office action and further in view of *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961))

Section 10 of the previous Office action sets forth how Wyman as modified by APA reads on the claims, however Wyman as modified does not appear to explicitly disclose that the access authorization indicator is included in the software program itself.

Resort may be had to *In re Wolfe* to teach that there is no novelty in integrating parts of a system if deemed desirable.

“It would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable.”

In the instant case it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wyman by integrating the access authorization indicator into the software program itself for the benefit of allowing the software to be installed and used on an isolated computer, i.e. one that does not have connection to the internet or other communication connections in order to verify authorization.

5. Claims 84-86, 87-92 and 94-104 are rejected under 35 U.S.C. 103(a) as being obvious over Ross (U.S. Patent 5,553,143) in view of Applicants Admitted Prior Art (APA) for the reasons set forth in section 11 of the previous Office action and further in view of *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961))

Section 11 of the previous Office action sets forth how Ross as modified by APA reads on the claims, however Ross as modified does not appear to explicitly disclose that the access authorization indicator is included in the software program itself.

Resort may be had to *In re Wolfe* to teach that there is no novelty in integrating parts of a system if deemed desirable.

"It would seem scarcely necessary to point out that merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desirable."

In the instant case it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ross by integrating the access authorization indicator into the software program itself for the benefits of, for example, allowing the software to be installed and used on an isolated computer, i.e. one that does not have connection to the internet or other communication connections in order to verify authorization.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DIG
2007-08-30


ELLA COLBERT
PRIMARY EXAMINER